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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,024	12/15/2003	Thomas E. Creamer	BOC9-2003-0078 (449)	4171
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EXAMINER				
SHIN, KYUNG H				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,024

Applicant(s)

CREAMER ET AL.

Examiner

KYUNG H. SHIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 5 - 9, 11-15, 17, and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 5 - 9, 11-15, 17, and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/2008 has been entered.
2. This application was filed on 12/15/2003. Claims **1 - 3, 5 - 9, 11 -15, 17, and 18** are pending. Claims **1, 7, 13** have been amended. Claims **4, 10, 16** have been cancelled. Claims **1, 7, 13** are independent.

Response to Arguments

3. Applicant's arguments with respect to claims **1 - 3, 5 - 9, 11 -15, 17, and 18** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1 - 3, 5 - 9, 11 -15, 17, 18** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Bice et al.** (US PG PUB No. **20020188688**) in view of **Escobar** (US Patent No. **5,926,100**) and further in view of **Yoakum et al.** (US PG PUB No. **20040059781**).

Regarding Claim 1, Bice discloses a method of permitting a user to remain in contact with at least one other entity comprising:

- a) establishing by the user a contact list comprising the at least one other entity;
(Bice para 059, ll 1-8: a contact list tool or address book; may be used to maintain records defining contact information)
- b) establishing by the user at least one service rule used for contacting the at least one other entity, wherein the service rule is user-customizable rule and is followed when attempted to reach the at least one other entity; (Bice para 014, ll 1-7: customer defined rules may be determined through a wizard presented to a customer; determine characteristics associated with a rule; apply a given rule to potential recipients by reference to a contacts list) and
- c) establishing by the user at least one contact rule used for contacting the user after the at least one other entity has been contacted. (Bice para 014, ll 1-7: customer defined rules determined through a wizard (user interface) presented to a customer; potential recipients of a given rule by reference to a contacts lists management tool)

Escolar discloses:

- e) obtaining information from the at least one other entity; (Escolar col 2, ll 3-6: contact person corresponding to the matched day and time is notified) and
- f) subsequently conveying the obtained information to the user if the at least one contact rule is satisfied. (Escolar col 2, ll 3-6: upon a successful match, a contact person corresponding to the matched contact is notified)

It would have been obvious to one of ordinary skill in the art to modify Bice to obtain information from other entity and conveying the obtained information to the user as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56: “... *In addition, conventional monitoring systems do not attempt to minimize the amount of time required to solve the problem forming the basis for the alarm, and also minimizing the inconvenience to the human operators. In view of the foregoing, it can be appreciated that a substantial need exists for a monitoring system which solves the above-discussed problems. ...*”)

Bice discloses wherein when the user is unavailable to initiate contact and eliciting the specified information according to the at least one service rule. (Bice para 010, ll 5-8: customer defined message handling rule which defines actions to be taken in the event of a message indicating a condition or event; para 011, 1-13: determine whether the customer-defined message handling rule should be applied to information message)) Bice does not explicitly disclose whereby automatically

contacting each entity, on the contact list.

However, Yoakum discloses:

d) automatically contacting each entity, on the contact list (see Yoakum para 005, ll 1-6; para 005, ll 12-14; para 0016, ll 1-9; para 018, ll 1-11: contact each entity on contact list to solicit information concerning entity)

It would have been obvious to one of ordinary skill in the art to modify Bice-Escolar as taught by Yoakum to enable the capability to automatically contacting each entity. One of ordinary skill in the art would have been motivated to employ the teachings of Yoakum in order to enable the capability for a simple and effective manner to manage a contact (buddy) list that a subscribing user would like to contact at any given time. (Yoakum para 004, ll 1-7: “... Accordingly, there is a need for a simple and effective technique to maintain buddy lists, which are highly reflective of the actual set of individuals that the subscribing user would like to monitor or contact at any given time. There is a further need to dynamically change the buddy list as necessary and temporarily select an individual not on the buddy list to monitor in a dynamic fashion. ... ”)

Regarding Claim 2, 8, 14, Bice discloses the method, machine-readable storage, system of claims 1, 7, 13, wherein the contact list is a database and the contact list includes information selected from names, phone numbers, email addresses, pager numbers, and a combination thereof. (Bice para 059, ll 5-8: provide a centralized point to allow contact information such as a phone number to be maintained; para 012, ll 1-6:

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embodied in a computer program)

Regarding Claims 3, 9, 15, Bice discloses the method, machine-readable storage, system of claims 1, 7, 13, wherein the at least one service rule is selected from how to contact the at least one entity and what to ask the at least one entity. (Bice para 011, ll 1-13: determine whether the customer-defined message handling rule should be applied to an information message (what to ask); applying the customer-defined message handling rule to the information message (how to contact)) Bice does not explicitly disclose a time period to contact the at least one entity. However, Escolar discloses wherein a time period to contact the at least one entity. (Escolar col 3, ll 11-16: a predetermined amount of time to try using the contact number)

It would have been obvious to one of ordinary skill in the art to modify Bice for a time period to contact the at least one entity as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56)

Regarding Claims 5, 11, 17, Bice discloses the method, machine-readable storage, system of claims 4, 7, 13, wherein the contact list and the user is contacted if the at least one contact rule has been satisfied. (Bice para 011, 1-13: determine whether the customer-defined message handling rule should be applied to information message; para 012, ll 1-6: embodied in a computer program) Bice does not explicitly disclose the

user is contacted after each of the at least two entities is contacted. However, Escolar disclose wherein the user is contacted after each of the at least two entities is contacted. (Escolar col 3, ll 11-12; col 3, ll 21-30: two entities on contact list; col 1, l 66 - col 2, l 12: upon a successful match, a contact person is notified a contact number corresponding to the matched contact day and time; if after a delay time alarm is not reset, a next contact number is used to notify a contact person; col 4, ll 43-49: if all alarms have not been cleared; steps are repeated using next contact number from list; process continues until alarms are cleared; (contact at least two entities))

It would have been obvious to one of ordinary skill in the art to modify Bice where the user is contacted after each of the at least two entities is contacted as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56)

Regarding Claims 6, 12, 18, Bice discloses the method, machine-readable storage, system of claims 4, 7, 13, wherein a contact list and the user is contacted if the at least one contact rule has been satisfied. (Bice para 011, 1-13: determine whether the customer-defined message handling rule should be applied to information message; para 012, ll 1-6: embodied in a computer program) Bice does not disclose the contact list comprises at least two entities and the user is contacted after all of the at least two entities is contacted. However, Escolar discloses wherein the contact list comprises at least two entities and the user is contacted after all of the at least two entities is

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contacted. (Escolar col 3, ll 11-12; col 3, ll 21-30: two entities on contact list; col 1, l 66 - col 2, l 12: upon a successful match, a contact person is notified a contact number corresponding to the matched contact day and time; if after a delay time alarm is not reset, a next contact number is used to notify a contact person; col 4, ll 43-49: alarms not cleared; steps are repeated using next contact; (all of the entities are contacted))

It would have been obvious to one of ordinary skill in the art to modify Bice where the user is contacted after all of the at least two entities is contacted as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56)

Regarding Claim 7, Bice discloses a machine-readable storage having stored thereon, a computer program having a plurality of code sections, the code sections executable by a machine for causing the machine to perform the steps of:

- a) establishing by the user a contact list comprising the at least one other entity; (Bice para 059, ll 1-8: a contact list tool or address book; may be used to maintain records defining contact information; para 012, ll 1-6: embodied in a computer program)
- b) establishing by the user at least one service rule used for contacting the at least one other entity, wherein the service rule is user-customizable and is followed when attempting to reach the at least one other entity; (Bice para 014, ll 1-7: customer defined rules may be determined through a wizard presented to a

customer; determine characteristics associated with a rule; apply a given rule to potential recipients by reference to a contacts list)

- c) establishing by the user at least one contact rule used for contacting the user after the at least one other entity has been contacted. (Bice para 014, ll 1-7: customer defined rules determined through a wizard (user interface) presented to a customer; potential recipients of a given rule by reference to a contacts lists management tool)

Escolar discloses:

- e) obtaining information from the at least one other entity; (Escolar col 2, ll 3-6: contact person corresponding to the matched day and time is notified) and
f) subsequently conveying the obtained information to the user if the at least one contact rule is satisfied. (Escolar col 2, ll 3-6: upon a successful match, a contact person corresponding to the matched contact is notified)

It would have been obvious to one of ordinary skill in the art to modify Bice to obtain information from other entity and conveying the obtained information to the user as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56)

Bice discloses wherein when the user is unavailable to initiate contact and eliciting the specified information according to the at least one service rule. (Bice para 011,

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1-13: determine whether the customer-defined message handling rule should be applied to information message) Bice does not explicitly disclose whereby automatically contacting each entity, on the contact list.

However, Yoakum discloses:

- d) when the user is unavailable to initiate contact, automatically contacting each entity, on the contact list (Yoakum para 005, II 1-6; para 005, II 12-14; para 0016, II 1-9; para 018, II 1-11: contact each entity on contact list to solicit information concerning entity)

It would have been obvious to one of ordinary skill in the art to modify Bice-Escolar for automatically contacting each entity as taught by Yoakum. One of ordinary skill in the art would have been motivated to employ the teachings of Yoakum in order to enable the capability for a simple and effective manner to manage a contact (buddy) list that a subscribing user would like to contact at any given time. (Yoakum para 004, II 1-7)

Regarding Claim 13, Bice discloses a system of permitting a user to remain in contact with at least one other entity comprising:

- a) means for establishing by the user a contact list comprising the at least one other entity; (Bice para 059, II 1-8: a contact list tool or address book; may be used to maintain records defining contact information)
- b) means for establishing by the user at least one service rule used for contacting the at least one other entity; (Bice para 014, II 1-7: customer defined rules may

be determined through a wizard presented to a customer; determine characteristics associated with a rule; apply a given rule to potential recipients by reference to a contacts list) and

- c) means for establishing by the user at least one contact rule used for contacting the user after the at least one other entity has been contacted. (Bice para 014, II 1-7: customer defined rules determined through a wizard (user interface) presented to a customer; potential recipients of a given rule by reference to a contacts lists management tool)

Escolar discloses:

- e) means for obtaining information from the at least one other entity; (Escolar col 2, II 3-6: contact person corresponding to the matched day and time is notified) and
- f) means for subsequently conveying the obtained information to the user if the at least one contact rule is satisfied. (Escolar col 2, II 3-6: upon a successful match, a contact person corresponding to the matched contact is notified)

It would have been obvious to one of ordinary skill in the art to modify Bice to obtain information from other entity and conveying the obtained information to the user as taught by Escolar. One of ordinary skill in the art would have been motivated to employ the teachings of Escolar in order to minimize the amount of time required to solve the problem and minimize the inconvenience to operators. (Escolar col. 1, lines 52-56)

Bice discloses wherein when the user is unavailable to initiate contact and eliciting

the specified information according to the at least one service rule. (Bice para 011, 1-13: determine whether the customer-defined message handling rule should be applied to information message) Bice does not explicitly disclose whereby automatically contacting each entity, on the contact list.

However, Yoakum discloses:

d) when the user is unavailable to initiate contact, automatically contacting each entity, on the contact list (Yoakum para 005, ll 1-6; para 005, ll 12-14; para 0016, ll 1-9; para 018, ll 1-11: contact each entity on contact list to solicit information concerning entity)

It would have been obvious to one of ordinary skill in the art to modify Bice-Escolar for automatically contacting each entity as taught by Yoakum. One of ordinary skill in the art would have been motivated to employ the teachings of Yoakum in order to enable the capability for a simple and effective manner to manage a contact (buddy) list that a subscribing user would like to contact at any given time. (Yoakum para 004, ll 1-7)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYUNG H. SHIN whose telephone number is (571)272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. FLYNN can be reached on (571) 272-1915. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyung Hye Shin
Examiner
Art Unit 2143

KHS
May 26, 2008

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154